

**REMARKS**

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

Claims 1-23 were pending in the instant application at the time of the outstanding Office Action. Of these claims, Claims 1, 12 and 23 are independent claims; the remaining claims are dependent claims. Claims 1-3, 6, 7, 10-14, 17, 18, and 21-23 have been rewritten.

Applicants are not conceding in this application the claims amended herein are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications. Applicants specifically state no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

The rejections in the outstanding Office Action are as follows: claims 1-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; claims 1, 12, and 23 stand rejected under 35 USC 102(b) as anticipated by Wolfinger et al., U.S. Patent No. 6,415,259 (hereinafter "Wolfinger"); claims 2-11 and 13-22 stand rejected under 35 USC 103(a) as being unpatentable over Wolfinger in view of Eilam et al., U.S. Pub. No.

2004/0111509 (hereinafter "Eilam"). Reconsideration and withdrawal of the rejections is hereby respectfully requested.

Before addressing the Examiner's rejections, a summary follows which was taken from the Specification, and should provide the Examiner with a better understanding of the instantly claimed invention. The instantly claimed invention is directed to an improved method for providing plans and schedules which maximize profits when accommodating change management requests in a computing system. Change Management is the process by which Information Technology (IT) systems are modified to accommodate considerations such as software fixes, hardware upgrades, and performance enhancements.

The change management process typically starts with the submission of a Request For Change (RFC), which can be viewed as a job in scheduling terms. This RFC describes what is to be done, usually in terms of hardware/software artifacts to change (deploy, install, configure, uninstall), or it might also indicate the deadline by which the change needs to be completed.

Change management is not a new concept, but the instantly claimed invention improves upon the existing methods for accomplishing change management. In the current state of the art Change Plans are created manually, not automatically. But this manual creation process is time consuming, difficult and error prone. For a large computing system it may be almost impossible. A need therefore exists for automating change management, and this is the problem, which the presently claimed invention addresses.

**Rejections under 35 U.S.C. 112**

Claims 1-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have rewritten Claims 1-3, 6, 7, 10-14, 17, 18, and 21-23 to correct the antecedent basis rejections cited by the Examiner.

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner states that it is uncertain what is meant by “request for change” (Office Action, page 2, paragraph 3). Also, the Examiner states that it is unclear how the step of “deciding” if a RFC should be done is performed (Office Action, page 3, paragraph 3). Applicants respectfully request reconsideration and withdrawal of this rejection.

The limitation in Claim 1, lines 1-2, “request for change” corresponds to the first step in the change management process in a computing system which typically starts with the submission of a request for change and can be viewed as a job in scheduling terms. *Specification*, page 1, lines 4-13. Similarly, the Examiner cites the same deficiency in Claims 12 and 23. The applicant respectfully submits that this is not indefinite as the Examiner asserts but is clear as presented in the application.

The limitation in Claim 1, line 3, “deciding” corresponds to a preliminary step in the change management process in a computing system, which in effect decides whether or not a schedule or change management is necessary. It is readily understood by one of

ordinary skill in the art that this step involves the submission of an RFCs or task which is to be completed as necessitating the change management process. Similarly, the Examiner cites the same deficiency in Claims 12 and 23. The Applicant respectfully submits that this is not indefinite as the Examiner asserts but is clear as presented in the application.

Claims 3-4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner states that it is not understood what is meant by “the value/the number of RFCs” (Office Action, page 3, paragraph 3). Applicants respectfully request reconsideration and withdrawal of this rejection.

In an effort to expedite prosecution, Applicants have amended Claim 3. Although the specification (page 7, line 6-7; page 9, lines 12-15) clearly discloses that the value is a profit value derived from performing a plurality of jobs associated with a selected subset of the RFCs, Applicants have added this language to the claim to clear up the confusion. . Claim 14 has been similarly rewritten. Therefore, Applicants respectfully submit that claims 3 and 14 are fully supported by the disclosure as originally filed and request withdrawal of the 35 U.S.C. § 112 rejection of claims 3 and 14.

Further, the limitation in Claim 4, “the number of RFCs” corresponds to a number of requests for change in the change management process in a computing system which is determined by what is to be done, usually in terms of hardware/software artifacts to change (deploy, install, configure, uninstall). *Specification*, page 1, lines 11-16. Similarly, the Examiner cites the same deficiency in Claim 15. The applicant respectfully submits that this is not indefinite as the Examiner asserts but is clear as

presented in the application, and thus request withdrawal of the 35 U.S.C. § 112 rejection of claims 4 and 15.

Claim 5 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner states that it is uncertain as to what is meant by “total downtime” (Office Action, page 3, paragraph 3). Applicants respectfully request reconsideration and withdrawal of this rejection.

The limitation in Claim 5, “total downtime” corresponds to the unavailability of the computer systems during the change management process. One skilled in the art would readily understand that “downtime” refers to downtime of the computing system for servicing the RFC. Moreover, the concept of “downtime” is described in the reference cited in the specification by D. Patterson, “A Simple Way to Estimate the Cost of Downtime.” *Specification*, page 16, lines 1-4. As stated in the Specification, it is to be assumed that all publications (including web-based publications) mentioned and cited in the Specification are thereby fully incorporated by reference therein as if set forth in their entirety therein. *Specification*, page 48, lines 6-9. Similarly, the Examiner cites the same deficiency in Claims 6, 16, and 17. The applicant respectfully submits that this is not indefinite as the Examiner asserts but is clear as presented in the application, and thus requests withdrawal of the 35 U.S.C. § 112 rejection of claims 5, 6, 16, and 17.

Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner states that it is unclear what “execution time” is referring to (Office Action, page 3, paragraph 3). Applicants respectfully request reconsideration and withdrawal of this rejection.

In an effort to expedite prosecution, Applicants have amended Claim 7. Although the specification (page 12, line 11-16; page 26, lines 3-6) clearly discloses that the execution time refers to the time associated with implementing a task, Applicants have added this language to the claim to clear up any confusion. Claim 18 has been similarly rewritten. Therefore, Applicants respectfully submit that claims 7 and 18 are fully supported by the disclosure as originally filed and request withdrawal of the 35 U.S.C. § 112 rejection of claims 7 and 18.

Claim 10 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner states that it is unclear what “the average response time of each RFCs” is (Office Action, page 3, paragraph 3). Applicants respectfully request reconsideration and withdrawal of this rejection.

The limitation in Claim 10, “average response time” corresponds to the amount of time a request has to wait (i.e. response time) before receiving the attention of the computer system during the change management process. It would be readily understood by one skilled in the art that “average response time” refers to this waiting time. Similarly, the Examiner cites the same deficiency in Claims 11, 21, and 22. The applicant respectfully submits that this is not indefinite as the Examiner asserts but is clear as presented in the application, and thus requests withdrawal of the 35 U.S.C. § 112 rejection of claims 10, 11, 21, and 22.

**Rejections under 35 U.S.C. 102(b)**

Claims 1, 12, and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wolfinger et al., U.S. Patent No. 6,415,259 (hereinafter “Wolfinger”).

Reconsideration and withdrawal of these rejections is respectfully requested in light of the following.

In rejecting the aforementioned claimed subject matter the Examiner points to Wolfinger as teaching various aspects of Applicants’ claimed invention. Applicants note the following regarding the teachings of the cited reference and its inapplicability to the instantly claimed invention.

Applicants respectfully submit that, as best understood, Wolfinger teaches a system of work progress tracking and management for scheduling completion of customer orders based on several optimization factors. Wolfinger’s combined system is designed for the Telecom Industry and manages workflow, the workforce, and scheduling and optimization of workflow and the workforce based on multiple parameters. (Col. 4, Lines 15-22). To contrast, the present application is not directed to management of a workforce, but rather optimally scheduling and managing changes within Information Technology (IT) systems.

Also, the changes referred to in Wolfinger and in the present application are also very different. Wolfinger’s changes refer to the changing internal and external factors such as changes in the orders being added, deleted, or modified and changes in the workforce situation due to sickness, or addition of new workers. (Col. 1, Lines 41-53).

The present application refers to scheduling the actual changes in the sense of when IT systems are modified to accommodate considerations such as software fixes, hardware upgrades and performance enhancements. (Specification, page 1, lines 9-11).

Further, the minimization of costs and the goals of optimization are very different between the two inventions. Wolfinger aims to complete customer orders by optimizing a human workforce, while the present application aims to optimize scheduling of the changes within a computing system through optimization of computer resources. Wolfinger specifically points out that the personnel or workforce is often the largest cost in many businesses, therefore this is the cost which is aimed to be minimized in that invention. (Col. 1, Lines 17-18; Col. 2, Lines 17-22). To contrast, in the present invention the costs are associated with the improper utilization of computer resources and computer system downtime.

More specifically, the Examiner claims that Wolfinger teaches scheduling tasks within at least one request for change within a computing system. (Office Action, page 4, paragraph 6). Applicants respectfully disagree, as Wolfinger only teaches scheduling customer orders and tasks while *utilizing* a computer system. Whereas the present application plans and schedules tasks and changes *within* a computing system. The two inventions are starkly dissimilar in this respect.

It is thus respectfully submitted that Wolfinger falls short of the present invention. Applicants further respectfully submit that the applied art does not anticipate the present invention because, at the very least, “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under construction.” W.L. Gore &

Associates, Inc. v. Garlock, 721 F.2d 1540, 1554 (Fed. Cir. 1983); see also In re Marshall, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

**Rejections under 35 U.S.C. 103(a)**

Claims 2-11, and 13-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfinger et al., U.S. Patent No. 6,415,259 (hereinafter “Wolfinger”) in view of Eilam et al., Pub. No. 2004/0111509 (hereinafter “Eilam”). Reconsideration and withdrawal of these rejections is respectfully requested in light of the following.

In rejecting the aforementioned claimed subject matter the Examiner points to Wolfinger and Eilam as teaching various aspects of Applicants’ claimed invention. Without addressing the substance of the rejection, although we reserve the right to, Applicants respectfully submit that it appears the Eilam reference does not qualify for use under § 103. As the Examiner is fully aware, under 35 U.S.C. § 103(c) if the referenced art was developed by the same assignee as the instant application it cannot be used in a rejection under § 103 after November 29, 1999.

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) was disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This amendment to 35 U.S.C. 103(c) was made pursuant to section 4807 of the American Inventors Protection Act of 1999 (AIPA).”

MPEP § 2146. Eilam and the instant application have the common assignee of International Business Machines Corporation. International Business Machines

Corporation appears as the owner of the Eilam application on the face of the published application, and the Assignment of the instant application to International Business Machines Corporation was recorded at the PTO on February 27, 2004 (Reel/Frame: 015034/0409).

Lastly, the Examiner provides that as per claims 10, 11, 21, and 22, Wolfinger in view of Eilam does not specifically teach the steps of minimizing the average response time and the weighted average response time of each RFCs. (Office Action, page 7, paragraph 17). Applicants agree with the Examiner on this, however the Examiner goes on to state that "it would have been obvious to one having ordinary skill in the art of scheduling optimization at the time of the applicant's invention to optimize the response time of the RFC in order to optimize the entire scheduling plan so that the penalty is reduced." (Office Action, page 7, paragraph 17). Applicants respectfully disagree with the Examiner on this point, as the steps of minimizing the average response time and the weighted average response time of each RFCs are essential steps of the instantly claimed invention. It is applicant's position that these steps would not be obvious to one skilled in the art and that the rejection of claims 10, 11, 21, and 22 should be withdrawn.

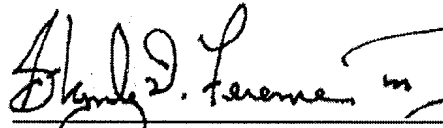
In light of the foregoing, it is respectfully submitted that the § 103 rejection be withdrawn as the above reference cited by the Examiner is disqualified art under § 103, and also because the invention would not be obvious to one of ordinary skill in the art.

**Conclusion**

In view of the foregoing, it is respectfully submitted that Claims 1, 12, and 23 fully distinguish over the applied art and are thus in condition for allowance. By virtue of dependence from what are believed to be allowable independent Claims 1 and 12, it is respectfully submitted that Claims 2-11, and 13-22 are also presently allowable. The teachings of Wolfinger clearly fall short of the instantly claimed invention and neither Eilam, nor any other cited art, account for these shortcomings.

In summary, it is respectfully submitted that the instant application, including Claims 1-23, is presently in condition for allowance. Notice to the effect is earnestly solicited. If there are any further issues in this application, the Examiner is again invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stanley D. Ference III", is written over a horizontal line.

Stanley D. Ference III  
Registration No. 33,879

**Customer No. 35195**  
FERENCE & ASSOCIATES LLC  
409 Broad Street  
Pittsburgh, Pennsylvania 15143  
(412) 741-8400  
(412) 741-9292 - Facsimile

Attorneys for Applicant